APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,651	06/27/2003	Mark R. Albrecht	171006-0001U3	7032

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EXAMINER
FRENEL, VANEL

ART UNIT	PAPER NUMBER
3687	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/608,651	ALBRECHT, MARK R.
	Examiner	Art Unit	
	VANEL FRENEL	3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>17 June 2009</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-12,31,32 and 34-52</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-12, 31, 32, 34-52</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/17/09

has been entered.

Notice to Applicant

2.   This communication is in response to the RCE filed on 6/17/09. Claims 1-12, 31-

32, and 34-52 are pending.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-12, 31-32 and 34-52 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Baker (6,473,741) in view of Carver (2004/0078307) and further in

view of SurePrep, Your Tax Preparation Partner (September 19, 2002) provided by Applicant.

As per claims 1-12, 31-32 and 34-52, Baker discloses for plural respective direct services providers, loading, onto a remotely accessible part of a common host server located in a given country, client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the client specific financial files and corresponding reference materials (See Baker, Col .10, lines 56-67 to Col .11, line 20); and monitoring and reporting the status of the tax return preparation and of the other financial service projects (See Baker, Col .12, lines 41-67).

Baker does not explicitly disclose a financial services outsourcing method for facilitating a direct service provider's management of human resources for providing financial services to numerous clients, the financial services being outsourced to an outsourcing group abroad, the method comprising: prioritizing tax returns for outsourcing, "wherein a tax return with a lower priority is outsourced before a tax return with a higher priority is outsourced"; providing the outsourced personnel limited access to the server; the outsourced personnel performing the tax return preparation services during the tax season in the given year and performing the financial service projects during a different season of the given year through a remote limited access client located in the outsource country.

However, these features are known in the art, as evidenced by Carver. In particular, Carver suggests a financial services outsourcing method for facilitating a

direct service provider's management of human resources for providing financial

services to numerous clients, the financial services being outsourced to an outsourcing

group abroad, the method comprising: <u>prioritizing tax returns for outsourcing (See</u>

<u>Carver, Page 4, Paragraph 0027);</u> "wherein a tax return with a lower priority is

outsourced before a tax return with a higher priority is outsourced (See Carver, Page 2,

Paragraph 0016; Page 4, Paragraph 0027; Page 5, Paragraph 0030); providing the

outsourced personnel limited access to the server (See Carver, Page 2, Paragraph

0016; Page 4, Paragraph 0027); the outsourced personnel performing the tax return

preparation services during the tax season in the given year and performing the

financial service projects during a different season of the given year through a remote

limited access client located in the outsource country (See Carver, Page 4, Paragraph

0027).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the features of Carver within the system of Baker with the

motivation of guarantying security of all identifying data and characteristics is provided,

and a user may utilize fictional euphemisms or other coded information as desired.

Password protection is required of all users and accounts (See Carver, Page 1,

Paragraph 0010).

As best understood, Baker and Carver teach all the limitations above. The

combination of Baker and Carver does not explicitly disclose retaining outsourced

personnel to perform tax return preparation services for clients of the direct service

providers during a tax season in a given year and to perform other financial service

projects for the clients of the direct service providers during a different season of the given year, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country.

However, this feature is known in the art, as evidenced by SurePrep. In particular, SurePrep suggests retaining outsourced personnel to perform tax return preparation services for clients of the direct service providers during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country (See SurePrep, NPL, Page 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of SurePrep within the teachings of Carver and Baker with the motivation of reducing cost.

As per claim 2, Baker discloses the method wherein the tax return preparation services comprise individual tax return preparation services (See Baker, Co1.10, lines 56-67 to Co1.11, line 2).

As per claim 3, Carver discloses the method wherein the tax returns and other financial services are outsourced through an intermediary firm to the outsourced personnel (See Carver, Page 4, Paragraph 0027).

As per claim 4, Carver discloses the method wherein the other financial service projects comprise bookkeeping projects (See Carver, Page 3, Paragraph 0020).

As per claim 5, Carver discloses the method further comprising the intermediary service firm interacting with the outsourced personnel through use of a servicing computer system, and interacting with the plural direct service providers through use of the servicing computer system (See Craver, Page 4, Paragraph 0025).

As per claim 6, Carver discloses the method wherein the direct service providers comprise accounting firms (See Craver, Page 4, Paragraphs 0025-0026).

As per claim 7, Carver discloses the method wherein the host server provides limited screen shot access to the remote client computer of information concerning the client specific financial files and corresponding reference materials (See Carver, Page 4, Paragraph 0026).

As per claim 8, Carver discloses the method wherein the host server comprises a CITRIX server (See Carver, Page 2, Paragraph 0016).

As per claim 9, Carver discloses the method wherein the host server provides limited screen shot access to the remote client computer of information concerning the

client specific financial files and corresponding reference materials (See Carver, Page 4, Paragraph 0026).

As per claim 10, Carver discloses the method according to claim 9, wherein the host server comprises a CITRIX server (See Craver, Page 2, Paragraph 0016).

As per claim 11, Carver discloses the method wherein the host server comprises an ASP server running tax software for use by plural independent direct service providers provided with access to the ASP server (See Carver, Page 2, Paragraphs 0016-0017).

As per claim 12, Carver discloses the method wherein the host server comprises an ASP server running tax software for use by plural independent direct service providers provided with access to the ASP server (See Carver, Page 2, Paragraphs 0016-0017).

As per claim 35, Carver discloses the method further comprising: interviewing one or more tax fliers (See Carver, Page 5, Paragraph 0030); and obtaining information from the one or more tax fliers (See Carver, Page 4, Paragraphs 0027-0028).

As per claim 36, Carver discloses the method wherein the information further comprises: prior year return information (See Carver, Page 1, Paragraph 0006); and

supporting documentation of the prior year return information (See Carver, Page 1,

Paragraph 0006).

   As per claim 37, Carver discloses the method further comprising: assigning, to an

individual preparer of the outsourced personnel, one or more tax returns of the tax

returns prioritized for outsourcing (See Carver, Page 4, Paragraph 0027); annotating, by

the individual preparer, each of the one or more tax returns assigned to the individual

preparer (See Carver, Page 4, Paragraphs 0025-0026); and completing, by the

individual preparer, each of the one or more tax returns assigned to the individual

preparer (See Carver, Page 5, Paragraph 0030).

   As per claim 38, Carver discloses the method further comprising: assigning, at a

first local time, the tax returns prioritized for outsourcing, the first local time

corresponding to an evening time in the United States (See Carver, Page 4, Paragraph

0027); and completing, before a second local time, the tax returns prioritized for

outsourcing, the second local time corresponding to the first morning time

in the United States after the evening time in the United States (See Carver, Page 4,

Paragraph 0027).

   As per added claim 39, Carver discloses the method further comprising:

reviewing, by a tax department or by a project manager, the completed tax returns

prioritized for outsourcing (See Carver, Page 4, Paragraph 0027).

As per claim 40, Carver discloses the method further comprising: generating a list of questions, the list of questions comprising missing information, the missing information required to complete a tax return of the tax returns prioritized for outsourcing (See Carver, Page 5, Paragraphs 0033-0034).

As per claim 42, Carver discloses the method wherein the contacting of the tax filer is outsourced (See Carver, Page 4, Paragraph 0027).

As per claim 43, Carver discloses the method wherein the transmitting of the missing information to the tax return preparer occurs by a computer network (See Carver, Page 2, Paragraph 0016).

As per claim 44, Carver discloses the method wherein the outsourcing of the tax return is determined by prioritizing of rates and margins (See Carver, Page 2, Paragraph 0017; Page 4, Paragraph 0026).

As per claim 45, Carver discloses the method further comprising outsourcing of bookkeeping of the information concerning the tax filer (See Carver, Page 3, Paragraph 0020).

As per claim 46, Carver discloses the method further comprising monitoring work time of the tax preparer (See Carver, Page 4, Paragraph 0027).

As per claim 47, Carver discloses the method of claim 41 further comprising instructing the tax preparer to perform other tasks, the other tasks not related to preparing the tax return (See Carver, Page 4, Paragraph 0027).

As per claim 49, Carver discloses the method wherein the lower priority tax return is a tax return with a smaller price than that of the higher priority tax return with a larger price (See Carver, Page 2, Paragraph 0016; Page 4, Paragraph 0027).

As per claim 50, Carver discloses the method wherein a tax return with lower priority is a tax return for an individual tax filer (See Carver, Page 2, Paragraph 0016; Page 4, Paragraph 0027).

As per claim 51, Carver discloses the method wherein the higher priority tax return is a tax return with a higher price than that of the priority tax return with a smaller price (See Carver, Page 2, Paragraph 0016; Page 4, Paragraph 0027).

As per claim 52, Carver discloses the method wherein a tax return with a higher priority is a tax return for a corporation (See Carver, Page 2, Paragraph 0016; Page 4,

Paragraph 0027).

Response to Arguments

5.   Applicant's arguments filed on 6/17/09 with respect to claims 1-12, 31, 32, and

34-52 have been considered but are moot in view of the new ground(s) of rejection.

In response, all of the limitations which Applicant disputes as missing in the applied

references, including the features newly added in the 6/17/09 amendment, have been

fully addressed by the Examiner as either being fully disclosed or obvious in view the

teachings of Baker, Carver and SurePrep based on the logic and sound scientific

reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in

the remarks and explanations given in the preceding sections of the present Office

Action and in the prior Office Action, and incorporated herein. One cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA

1981); In re Merck & Co., 800 F.2d 1091,231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary

reference may be bodily incorporated into the structure of the primary reference; nor is it

that the claimed invention must be expressly suggested in any one or all of the

references. Rather, the test is what the combined teachings of the references would

have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208

USPQ 871 (CCPA 1981).

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/

Primary Examiner, Art Unit 3687

August 30, 2009